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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,253	04/26/2006	Kyoichi Kato	290245US3PCT	9670

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ELKINS, GARY E

ART UNIT	PAPER NUMBER
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3782

NOTIFICATION DATE	DELIVERY MODE
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06/18/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/577,253	Applicant(s) KATO, KYOICHI	
	Examiner Gary E. Elkins	Art Unit 3782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060720, 20060426</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, “a front facing side wall” is a double inclusion of an element insofar as the sidewalls were previously defined in the claims.

In claim 4, “a brim piece” is a double inclusion of an element since the brim piece was previously set forth in the claims.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adsit et al (US 1,989,659) in view of either Pany (US 4,978,009) or Howell et al (US 6,957,765) and any one of De Fiori et al (EP 430,013), Seegmiller (US 1,079,583), Keeler (US 581,234) or Heron (US 312,851). Adsit discloses all structure of the claimed box except formation of the box from plastic and positioning of the brim piece (31) shifted from the center of the bend line, and, with respect to claim 5, formation of the brim piece with a width of 5 to 20 mm and a length of .5 to 2 mm. Each of Pany and Howell et al teaches that it is known to make cartons from plastic. Each of De Fiori et al, Seegmiller, Keeler and Heron teaches that it is known to make a finger

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engagement area (16'; a5; d; upper edge of E as shown in fig. 1, respectively) offset from the center of a tuck flap. It would have been obvious to make the carton in Adsit et al from plastic as taught by either Pany or Howell et al to acquire the well known advantages of plastic over paperboard, i.e. water resistance, durability, etc. It would further have been obvious to offset the finger engagement tab or brim piece in Adsit et al as taught by any one of De Fiori et al, Seegmiller, Keeler or Heron to make it easier to release the tuck flap by pulling one side upwardly and then the other side, i.e. to decrease the pressure needed to release the tuck flap. With respect to claim 5, it would have been obvious to make the dimensions of the brim piece in Adsit et al with a width between 5 and 20 mm and a length between .5 and 2 mm as a matter of routine experimentation in determining the optimal size of the tab. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See In re Boesch, 617 f.2d 272, 205 USPQ 215 (CCPA, 1980).

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of any one of Keefe et al (US 4,809,908), Wasyluka (US 2,630,962) or Blitz (US 1,830,420). Modified Adsit et al evidences all structure of the claimed box except formation of a cutout along the edge of the side wall where the brim piece faces. Each of Keefe et al, Wasyluka and Blitz teaches that it is known to make a finger engagement cutout (11; 11 in fig. 18; 28, respectively) in position with a brim piece. It would have been obvious to make the box of Adsit et al with a cutout as taught by any one of Keefe et al, Wasyluka or Blitz to allow easier finger engagement of the brim piece.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Sternau (US 3,484,034). Modified Adsit et al evidences all

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structure of the claimed box except a right angled or rectangular shape to the brim piece, i.e. the shape of the brim piece in Adsit et al is trapezoidal. Sternau teaches that it is known to make a finger tab (38) with a right angled rectangular shape. It would have been obvious to make the tab or brim piece in Adsit et al with a right angled shape as taught by Sternau as a mere selection of one known finger engagement tab shape over another and as a simple substitution of one known shape for another to obtain predictable results. See KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1742; 82 USPQ2d 1385, 1396 (2007).

Conclusion

The remaining cited prior art is illustrative of the general state of the art.

Any inquiry related this office action or any other office action for this application should be directed to Examiner Gary Elkins at the number listed below. Normal work days are Mon, Wed and Fri.

If the Examiner is unavailable and you need to talk to someone sooner, the Examiner's supervisor, Mr. Nathan Newhouse may be contacted at the number listed below.

Information regarding the status of an application may also be obtained by accessing the PAIR system. Information about the PAIR system can be obtained at the website <http://pair-direct.uspto.gov> or by contacting the Electronic Business Center (EBC) at (866) 217-9197 (toll free). You may also contact a USPTO Customer Service Representative or access the automated information system at 1-800-786-9199 (in USA or Canada) or 1-571-272-1000.

/Gary E. Elkins/

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